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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,955	01/26/2006	Lutz Wolfgang Gruneberg	051082	8456
20/306 7590 10/08/2010 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
KARIKARI, KWASI				
ART UNIT		PAPER NUMBER		
2617				
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10/08/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,955

Applicant(s)

GRUNEBERG ET AL.

Examiner

KWASI KARIKARI

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 9 and 16-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 04/14/2010, with respect to the pending claims have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as shown below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, 7-8, 10 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheung et al.,(U.S 2003/0088693), (hereinafter, Cheung).

Regarding claims 1, 7-8 and 10, Cheung discloses a system/method for handling email requests received from a terminal (= computer 104, see [0024 and 0029]) for sending email from the terminal (see [0002, 0019, 0024, 0026 and 0029]), the system comprising:

at least one email proxy (= server 102) and a database (= database 103), the email proxy being configured to communicate with the database (= server 102 access database 103, see [0026]), wherein the email proxy is configured to detect a unique

network address of the terminal (= user message to server 103 includes user's telephone number, see [0026-27])

and retrieve email configuration settings from the database using the unique network address of the terminal (= server 102 format the message into an email that includes user's information from the database 103; the email is then forward to email serve 110/112, see [0026-27]; whereby the "email configuration settings", is being associated with the unique address of the email server 110/112) and, without sending the retrieved email configuration settings back to the terminal, to communicate with an email server using the retrieved email configuration settings (= server 102 communicates with server 110, see [0027, 0029 and 0031]).

Regarding claim 4, as recited in claim 1, Cheung discloses the system, wherein the database (= database 103) comprises a mapping of the unique network address of the terminal to an identity of a user (see [0026]).

Regarding claim 5, as recited in claim 4, Cheung discloses the system, wherein a first database (= database 103) comprises the mapping of the unique network address of the terminal to the identity of the user, and second database (= server 102) comprises the retrieved email configuration settings (see [0026-27]).

Regarding claim 13, as recited in claim 10, Cheung discloses the method, wherein the database (= database 103) comprises a mapping of the unique network address of the terminal to an identity of a user (see [0026-27]).

Regarding claim 14, as recited in claim 13, Cheung discloses the method comprising the steps of retrieving from a first database (= database 103) information about the mapping of the unique network address of the terminal to the identity of the user; and retrieving, from a second database(= server 102), the email configuration settings (see [0026-27]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung in view of Applicant's Admitted Prior Art (hereinafter, AAPA).

Regarding claim 2, as recited in claim 1, **Cheung** does not explicitly teach about email configuration settings including -- a name of an email server, and a username and a password for accessing the email server, as claimed by applicant.

However, **APA**, teaches that -- a name of an email server, a user name and a password are known to be used for email retrieval (see page 2, lines 1-4. (7)).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Cheung to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

Regarding claim 3, as recited in claim 2, **Cheung** does not explicitly teach the system, wherein the email configuration settings further include: a full name of a user and an email address of the user.

However, **APA**, teaches the system, wherein the email configuration settings further include: a full name of a user (see page 2, lines 16-20), and an email address of the user (see page 2, lines 16-20).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Cheung to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

Regarding claim 11, as recited in claim 10, the features of claim 11 are similar to the features of claim 2. Hence, claim 11 is rejected on the same ground and motivation as claim 2.

Regarding claim 12, as recited in claim 11, the features of claim 12 are similar to the features of claim 3. Hence, claim 12 is rejected on the same ground and motivation as claim 3.

4. **Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung in view of Bern et al., (U.S 2002/0009986), (hereinafter, Bern).**

Regarding claims 6 and 15, as recited in claims 1 and 10, **Cheung** explicitly fails to disclose the system/method, wherein a first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages.

However, **Bern**, which is an analogous art discloses: "a first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages" (= POP3 and SMTP, see [0005-8]).

Therefore, it would have been obvious at the time the invention was made for one of the ordinary skill in the art to have combined the teaching of Bern with Cheung for the benefit of a communication system that facilitates email retrieval, thereby increasing system performance.

Allowable Subject Matter

5. Claims 9 and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For example adding the objected claims with the independent claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See also, the attached PTO-892

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (7am - 5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kwasi Karikari/
Patent Examiner (PSA): Art Unit 2617.